

REMARKS

The Applicants have filed the present Amendment and Response in reply to the outstanding Official Action of September 13, 2005, and the Applicants believe the Amendment and Response to be fully responsive to the Official Action for the reasons set forth below in greater detail.

In the outstanding Official Action, the Examiner rejected Claims 9-12 and 36-38 under 35 U.S.C. § 112, first paragraph, based upon the product claim reference to method steps. The claims have been amended to overcome the rejections.

§ 102 REJECTION

In the outstanding Official Action, the Examiner rejected Claims 1, 5, 9, 16, 19, 26, 29 and 37 under 35 U.S.C. § 102(b) as being anticipated by Nakano et al., United States Patent No. 5,901,366 (hereinafter "Nakano").

Applicants respectfully disagree with the Examiner's rejection and traverse with at least the following analysis. Applicants submit that the reference fails to teach storing the various remote control codes and transmitting the stored codes to the target equipment as recited in each of the rejected independent claims.

Nakano teaches a cordless telephone that transmits an RF signal to a base unit. The base unit receives the signal and demodulates the signal. The base unit then converts the received RF signal into a DTMF signal, which corresponds to the depressed input signal. The DTMF signal is outputted via a line interface from the modular jack. Specifically, the DTMF signal outputted from the modular jack of the base unit is **inputted to a modem unit of the receiver 2**. The modem 632, at receiver 2, decodes the DTMF signal into a code of an original numeral. In other words, the receiver 2 converts the received DTMF signal into remote control codes.

Nakano specifically states:

In the ROM 37 of the receiver 2, information representing that the function applied to the numeral 0 key as a remote commander is a function of causing a multi-preview screen to be displayed is registered. Thus, in accordance with the registration, the CPU 29 instructs the front end circuit 20 to receive a transmission channel for archived data. In response to the instruction, archived data are supplied from the front end circuit 20 to the demultiplexer 24.

Col. 14:41-48.

The reference clearly teaches that the receiver 2 and not the cordless phone, performs any encoding or decoding. The cordless phone transmits a RF signal based upon a key depression and is independent from any target equipment remote control code. Additionally, the cellular phone does not appear to have any codes stored in memory. In fact, the reference fails to even mention or reference any memory means or section in the remote cordless phone. Additionally, the cordless phone 5 does not transmit any codes to the target equipment; the cordless phone only transmits an RF signal independent of the codes.

In stark contrast, in the claimed invention, various remote control codes for target equipment are associated with a plurality of operating buttons in a one-to-one relationship. This association is stored as a data set in **memory of the mobile phone**. When a user depresses one of the plurality of operation buttons, the control unit reads a remote control code associated with the pressed button from the data set and transmits the code to the target equipment.

Accordingly, Applicants respectfully submit that the reference fails to teach or suggest each and every limitation of Claims 1, 5, 9, 16, 19, 26, 29 and 37. Therefore, the claims are patentable over Nakano. Applicants request that the Examiner withdraw the rejection.

§ 103 REJECTION

In the Official Action, the Examiner rejected Claims 2, 3, 6, 7, 10 and 11 under 35 U.S.C. § 103(a) as being unpatentable over Nakano in view of Goldstein, United States Patent No. 5,410,326 (hereinafter "Goldstein").

Applicants respectfully disagree with the Examiner's rejection and traverse with at least the following analysis. Goldstein does not cure the above-identified deficiencies. Specifically, Goldstein is not directed to a mobile telephone.

Additionally, any hypothetical combination made to obtain the claimed invention would change the primary operation of the primary reference. A combination or modification cannot change the operability of the primary reference. If one of ordinary skill in the art would combine Goldstein and Nakano to store code in the memory of the cordless phone, the combination would eliminate the need for the base unit and receiver, but yet keep the function. However, there is no motivation to eliminate these structures. Additionally, as stated above, Nakano does not teach or suggest that the cordless phone headset includes a memory section.

Therefore, Applicants submit that one of ordinary skill in the art would not make the alleged combination.

Further, the Examiner rejected Claims 4, 8, 12, 13, 18, 21, 8, 31, 35, and 29 under 35 U.S.C. § 103(a) as being unpatentable over Nakano in view of Wall et al, United States Pub No. 2003/0156053 (hereinafter "Wall").

Applicants respectfully disagree with the Examiner's rejection and traverse with at least the following analysis.

Wall teaches downloading various remote control codes associated with a plurality of operation buttons. The cited hypothetical combination of Nakano and Wall would change the

primary operation of the reference, which uses an **external receiver 2 to convert signals** from a cordless phone to control multiple targets. Nakano already teaches an entire system capable of remotely controlling a plurality of devices using a cordless phone. In Nakano, the cordless phone transmits a signal that corresponds to a key depression without a dependency on the type of target.

The Examiner has not provided a proper motivation to combine the references, which is dispositive of an obviousness case. To establish obviousness, the Examiner must make a showing of a suggestion or motivation in the art to combine the references. In re Rouffet, 149 F.3d 1350, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998). The absence of such a suggestion to combine is dispositive in an obviousness determination. See Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 U.S.P.Q.2d 1378, 1383 (Fed. Cir. 1997). “The showing of a motivation to combine must be clear and particular, and it must be supported by actual evidence.” Teleflex, Inc. v. Ficosa North American Corp., 299 F.3d 1313, 63 U.S.P.Q.2d 1374 (Fed. Cir. 2002) (Citing In re Dembiczak, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999)).

There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. In re Rouffet, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998). The motivation can come from the nature of the problem, the reference, or common knowledge. Id.

There would be no motivation to modify Nakano to (I) transmit an RF signal dependent on the target device, (II) eliminate the receiver, (III) include a memory in the cordless headset, and (IV) transmit the RF signal directly to the target device. Such a radical change is neither suggested nor taught by Nakano and Wall.

Additionally, *pro arguendo*, even if there was a motivation, Wall fails to teach a one-to-one relationship as specifically recited in the claims. Wall solely teaches downloading codes from a remote location.

Accordingly, Applicants submit that Claims 4, 8, 12, 13, 18, 21, 8, 31, 35, and 29 are patentably distinct from the cited hypothetical combination; the references whether taken alone or in any combination thereof fail to teach, suggest or render obvious each and every limitation of these claims.

The Examiner also rejected Claims 14 and 15 under 35 U.S.C. § 103(a) as being unpatentable over Nakano, Wall, and Goldstein. Applicants respectfully disagree with the Examiner's rejection and traverse with at least the following analysis. Applicants submit that there is a lack of motivation to combine the reference based upon the reasons set forth *supra*.

Accordingly, Applicants submit that Claims 14 and 15 are patentably distinct from the cited hypothetical combination; the references whether taken alone or in any combination thereof fail to teach, suggest or render obvious each and every limitation of these claims.

The Examiner also rejected Claims 17, 20, 27, and 30 under 35 U.S.C. § 103(a) as being unpatentable over Nakano in view of August et al., United States Patent No. 5,671,267 (hereinafter "August"). Applicants respectfully submit that August does not cure the above-identified deficiencies with Nakano. Specifically, the combined references fail to teach storing the various remote control codes and transmitting the stored codes to the target equipment

Accordingly, Applicants submit that Claims 7, 20, 27, and 30 are patentably distinct from the cited hypothetical combination; the references whether taken alone or in any combination thereof fail to teach, suggest or render obvious each and every limitation of these claims.

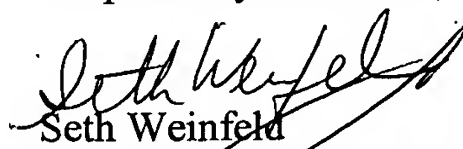
The Examiner also rejected Claims 22, 32, and 38 under 35 U.S.C. § 103(a) as being unpatentable over Nakano in view of Cheng, United States Patent Pub. 2004/0229694; Claims 23, 24, 33, and 34 as being unpatentable over Nakano in view of Cheng and August; and Claim 25 as being unpatentable over Nakano in view of Cheng and Wall.

Applicants respectfully disagree with the Examiner's rejections and traverse with at least the following analysis. Applicants submit that none of the references teach a first, second, or third remote control mode as recited in Claims 22, 32, and 38.

For all the foregoing reasons, the Applicants respectfully request the Examiner to withdraw the rejections of 9-12, and 36-38 pursuant to 35 U.S.C. § 112, first paragraph. Furthermore, Applicants respectfully request the Examiner to withdraw the rejections of Claims 1, 5, 9, 16, 19, 26, 29 and 37 pursuant to 35 U.S.C. § 102(e). Lastly, the Applicants respectfully request the Examiner to withdraw rejections of Claims 2-4, 6-8, 10-14, 15, 17, 18, 20-24, 27, 29-35 and 38 pursuant to 35 U.S.C. § 103(a).

In conclusion, the Applicants believe that the above-identified application is in condition for allowance and henceforth respectfully solicit the Examiner to allow the application. If the Examiner believes a telephone conference might expedite the allowance of this application, the Applicants respectfully request that the Examiner call the undersigned, Applicants' attorney, at the following telephone number: (516) 742-4343.

Respectfully submitted,


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